



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,299	11/17/2003	John W. Steedly	4060	5225
27727	7590	12/14/2005	EXAMINER	
PEDERSEN & COMPANY, PLLC P.O. BOX 2666 BOISE, ID 83701			HANSEN, JAMES ORVILLE	
			ART UNIT	PAPER NUMBER
			3637	
DATE MAILED: 12/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/715,299

**Applicant(s)**

STEEDLY, JOHN W.

**Examiner**

James O. Hansen

**Art Unit**

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 29, 2005 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 9, lines 16-18, the phrase "upper element which forms a removable lid having external dimensions equal to or slightly less than the internal dimensions of the top edges of the..." is deemed to be misdescriptive of the embodiments since the upper element comprises a top portion and a bottom portion, as viewed by the examiner, with the top portion resting on the top edges of the claimed elements while the bottom portion is dimensioned to fit within the storage space defined by the claimed elements [basically, a portion of the lid rests on the elements while a remaining portion of the lid is able to fit within the elements]. Appropriate correction is required. In Claim 10, the phrase "elements of a display case are..." is unclear and confusing since it is not clear if the "display case" is a new and distinct limitation or if the "case" constitutes one of the previously defined "display

Art Unit: 3637

cases. Consequently, the remaining claims are rejected since they are dependent upon an indefinite claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan [U.S. Patent No. 6,325,281] in view of Hannaford [U.S. Patent No. 1,865,688]. Grogan (figures 1-4) teaches of a plurality of display cases (30, 40 for example), wherein the display cases are of increasing size (30 bigger than 40), and wherein the smaller sized display case is of a dimension such that that it is capable of being stored inside the larger sized display case, and wherein the display cases are capable of being attached to each other (such as in a nested arrangement) to form a single display unit, wherein each display case is comprised of upper, lower, front, rear and side elements (all disclosed in the specification), wherein the lower, front, rear and side elements of the display case are composed of polystyrene foam [expanded & open-cell polystyrene], wherein the lower element of at least the small case connects to the front, rear and side elements along the bottom edge of the front, rear and side elements, wherein the front, rear and side elements connect to one another along the vertical edges of the front, rear and side elements, wherein the lower, front, rear and side elements form a container capable of storing items for display, wherein the upper element (62, 63) forms a removable lid that fits within the front, rear and side elements, and wherein

Art Unit: 3637

the lid for the larger container contains a top surface (61) capable of holding displayed items. Grogan teaches applicant's inventive claimed structure as disclosed above, but does not show each case as having a separate element forming a removable lid.

Hannaford (figures 1-20) is cited as an evidence reference to show that it was known at the time the invention was made to provide a plurality of nested cases (3, 4) with a distinct removable lid (5, 6) for each case. Accordingly, the position is put forth that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the lid arrangement of Grogan so as to utilize a separate lid for each display case as taught by Hannaford because this arrangement would ensure a closed sealed system when the cases are nested and shipped together and provides the additional function of allowing the cases to be separated from each other while still retaining the ability to enclose each individual display case [Grogan was unable to enclose each case when separated].

As to the inclusion of more display cases within the system, it is viewed that the addition of another smaller case may be implemented depending upon the needs of the user, since such duplication of the parts i.e., an additional case, involves only routine skill in the art.

6. Claims 10, 12-13 & 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan and Hannaford and further in view of Morrison [U.S. Patent No. 4,325,597]. The examiner has taken the position that only the largest case [or exterior case when cases are nested] utilizes the covering. The prior art teaches applicant's inventive claimed structure as disclosed above, but does not show a carpet or fabric covering some of the elements [front, rear, side]. Morrison (figures 1-49) is cited as an evidence reference to show that it was known in the art to utilize a fabric

Art Unit: 3637

or carpet to cover elements of a structure. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the exterior case of Grogan so as to incorporate a fabric or carpet layer on the front, rear and side elements as taught by Morrison because this arrangement would provide the case of the prior art with a more esthetically pleasing appearance. It is noted that fire retardant is commonly utilized within fabrics and carpets. The vertical elements of the cases being substantially rectangular, while the upper and lower elements are substantially square (note the figs.).

As to the type of material utilized for the elements and the top surface, the position is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the type of material used to construct elements of the case, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as an obvious matter of personal preference. Accordingly, where the material is not functionally related in a new or unobvious way to the device upon which it is assembled, the material will not distinguish the invention from the prior art in terms of patentability.

As to the bonding of the elements via an adhesive, the examiner takes the position that one of ordinary skill in the art at the time the invention was made would deem the incorporation of an applied adhesive to adjacently positioned elements for the purposes of securely attaching the elements in a prescribed configuration as an obvious adaptation not rising to the level of novelty for patentability purposes.

7. Claims 11 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan, Hannaford, Morrison and further in view of Thor. The prior art teaches

Art Unit: 3637

applicant's inventive claimed structure as disclosed above, but does not show a side element containing a hook and loop connector to allow for multiple cases to be attached. Thor (figures 1-5) is cited as an evidence reference to show that it was known in the art to utilize a hook and loop connector (49) on a side element of a case for the purpose of attaching the case to another object with a mating hook and loop connector. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the case of the prior art so as to incorporate a hook and loop connector (Velcro) onto a side element of the prior art's case as taught by Thor because this arrangement would allow the case of the prior art to be fastened to an adjacent structure employing a mating strip of a Velcro thereby removably attaching both structures to each other.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan, Hannaford, Morrison and further in view of Sabol Jr. The prior art teaches applicants inventive claimed structure as disclosed above, but does not show the elements of the case being connected via rabbetted joints. Sabol (figures 1-14) is cited as an evidence reference to show that it was known in the art to join elements of a case together with the use of rabbetted joints. Sabol shows a case formed by elements having rabbet joints (fig. 3 for example). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the element joining means of the prior art by utilizing the rabbetted joints as taught by Sabol because this arrangement would provide the prior art with a more stable and semi-permanently erected case that is constructed without the aid of tools and mechanical fasteners yet is more structurally sound due to the interconnection of the jointed elements [as opposed to joining elements along a single flat surface].

Art Unit: 3637

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roop [U.S. Patent No. 2,575,770]. Roop (figures 1-4) teaches of a plurality of display cases (A,B,C,D), wherein the display cases are of increasing size (A bigger than D), and wherein the smaller sized display case is of a dimension such that that it is capable of being stored inside the larger sized display case, and wherein the display cases are capable of being attached to each other (such as in a nested arrangement) to form a single display unit, wherein each display case is comprised of upper, lower, front, rear and side elements (see figures), wherein the lower, front, rear and side elements of the display case are composed of a synthetic resinous material, wherein the lower element of at least the small case connects to the front, rear and side elements along the bottom edge of the front, rear and side elements, wherein the front, rear and side elements connect to one another along the vertical edges of the front, rear and side elements, wherein the lower, front, rear and side elements form a container capable of storing items for display, wherein each case includes an upper element (7) forming a removable lid that fits on the top edges of the elements and within the front, rear and side elements of each respective case (fig. 2), and wherein the lid for the larger container contains a top surface (fig. 1) capable of holding displayed items. Roop teaches applicant's inventive claimed structure as disclosed above, but does not teach the material of the cases as being polystyrene foam. As to the type of materials utilized for the elements in making the cases, the position is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the type of material used to construct the elements of the case, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as an obvious matter of



Art Unit: 3637

personal preference. Accordingly, where the material is not functionally related in a new or unobvious way to the device upon which it is assembled, the material will not distinguish the invention from the prior art in terms of patentability.

10. Claims 10, 12-13 & 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roop in view of Morrison [U.S. Patent No. 4,325,597]. The examiner has taken the position that only the largest case [or exterior case when cases are nested] utilizes the covering. Roop teaches applicant's inventive claimed structure as disclosed above, but does not show a carpet or fabric covering some of the elements [front, rear, side]. Morrison (figures 1-49) is cited as an evidence reference to show that it was known in the art to utilize a fabric or carpet to cover elements of a structure. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the exterior case of Roop so as to incorporate a fabric or carpet layer on the front, rear and side elements as taught by Morrison because this arrangement would provide the case of Roop with a more esthetically pleasing appearance. It is noted that fire retardant is commonly utilized within fabrics and carpets. The vertical elements of the cases being substantially rectangular, while the upper and lower elements are substantially square (note the figs.).

As to the type of material utilized for the elements and the top surface, the position is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the type of material used to construct elements of the case, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as an obvious matter of personal preference. Accordingly, where the material is not

Art Unit: 3637

functionally related in a new or unobvious way to the device upon which it is assembled, the material will not distinguish the invention from the prior art in terms of patentability.

As to the bonding of the elements via an adhesive, the examiner takes the position that one of ordinary skill in the art at the time the invention was made would deem the incorporation of an applied adhesive to adjacently positioned elements for the purposes of securely attaching the elements in a prescribed configuration as an obvious adaptation not rising to the level of novelty for patentability purposes.

11. Claims 11 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roop, Morrison and further in view of Thor. The prior art teaches applicant's inventive claimed structure as disclosed above, but does not show a side element containing a hook and loop connector to allow for multiple cases to be attached. Thor (figures 1-5) is cited as an evidence reference to show that it was known in the art to utilize a hook and loop connector (49) on a side element of a case for the purpose of attaching the case to another object with a mating hook and loop connector.

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the case of the prior art so as to incorporate a hook and loop connector (Velcro) onto a side element of the prior art's case as taught by Thor because this arrangement would allow the case of the prior art to be fastened to an adjacent structure employing a mating strip of a Velcro thereby removably attaching both structures to each other.

#### ***Response to Arguments***

12. Applicant's arguments and amendments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3637

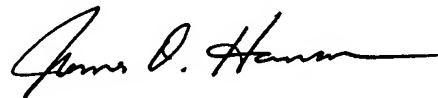
**Conclusion**

**13.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McColl describe a plurality of nested display cases each with a removable lid.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Hansen whose telephone number is 571-272-6866. The examiner can normally be reached on Monday-Friday between 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James O. Hansen  
Primary Examiner  
Art Unit 3637

JOH  
December 9, 2005